

REMARKS/ARGUMENTS

Claims 1-13 and 37 are pending in the present application after this amendment withdraws claims 14-36 and adds new claim 37. The amendments do not add new matter and find support throughout the specification and figures.

Applicant hereby elects the claims of Group I as presented in the Election/Restriction in the Office Action of June 21, 2004, and therefore claims 14-36 are withdrawn from consideration. In view of the Examiner's restriction requirement, Applicant retains the right to present claims 14-36 in a divisional application. Claims 1-13 stand rejected under 35 U.S.C. § 103(a). It is respectfully submitted that all of the presently pending claims are allowable for at least the following reasons.

35 U.S.C. § 103(a)

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,368,658 to Schwarz et al. (the Schwarz reference) in view of United States Patent Publication No. 2003/0230819 to Park et al. (the Park reference). Applicant respectfully submits that claims 1-13 are in condition for allowance, for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art **teach or suggest each element of the claim**, but the prior art must also **suggest combining the elements in the manner contemplated by the claim**. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, **to modify or combine the references** and that, when so modified or combined, the prior art **teaches or suggests all of the claim limitations**. M.P.E.P. §2143. Applicant respectfully submits that these criteria for obviousness are not met here.

Independent claim 1 relates to a method for coating a medical appliance that includes, among other things, suspending the at least one medical appliance in a fluidizing gas flow and

directing a coating onto an ultrasonic nozzle. The ultrasonic nozzle is directed towards the medical appliance. The method according to claim 1 also includes vibrating the ultrasonic nozzle at a rate sufficient to atomize the coating.

Although the Examiner admits that the Schwarz reference fails to teach the use of an ultrasonic nozzle to coat a medical appliance (Office Action; page 5, ll. 1-3), the Examiner asserts that this feature is taught by the Park reference.

It is respectfully submitted that there is no suggestion in the prior art to modify the Schwarz reference in view of the Park reference in order to arrive at the invention of claim 1. The Examiner asserts that it would have been obvious to employ in the Schwarz reference the teaching of the Park reference. However, the Schwarz reference apparently relates to a coating method using air suspension. The Schwarz reference gives no suggestion of the usefulness of a combination with the ultrasonic atomizer apparently discussed in the Park reference. The Schwarz reference apparently discusses the use of low velocity air streams, but does not discuss, or even suggest, the use of an ultrasonic nozzle. Furthermore, the Schwarz reference apparently discusses low velocity nozzles in the context of injecting the coating material into a chamber (Schwarz; col. 9, ll. 8-11), but does not discuss atomizing a coating material with a low-velocity nozzle, nor more particularly, atomizing a coating material using an ultrasonic nozzle. The Schwarz reference does not express any problem or unmet need that would motivate a practitioner to use an ultrasonic nozzle in combination with the method and apparatus of the Schwarz reference.

Similarly, the Park reference provides no motivation to combine the ultrasonic atomizer of the Park reference with the air suspension method of the Schwarz reference. The Park reference does apparently discuss coating stents, but does not discuss, or even suggest coating stents using an air suspension method, as apparently discussed in the Schwarz reference. The only motivation to combine the references comes from the disclosure of the Applicant, which constitutes improper hindsight reasoning. Since there is no motivation or suggestion to combine the references, the references do not render the subject matter of claim 1 obvious.

Claims 2-13 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

Furthermore, claim 3 includes the operation of directing the fluidizing gas flow at the ultrasonic nozzle. The fluidizing gas flow of claim 3 transports the atomized coating to the at least one medical appliance. The Schwarz reference apparently discusses using multiple nozzles, and apparently discusses using low-velocity nozzles to inject coating into a chamber (Schwarz; col. 9, ll. 8-11), but the Schwarz reference does not suggest using the fluidizing gas flow to transport atomized coating to the appliance.

For at least the reasons discussed above, withdrawal of the rejections under 35 U.S.C. §103(a) with respect to claims 1-13 is hereby respectfully requested.

New Claim

New claim 37 finds support throughout the specification and figures, and in particular at page 6, ll. 20-23, et. seq., and figure 2. Claim 37 depends from claim 1 and is therefore allowable for at least the same reasons as claim 1 is allowable. Additionally, claim 37 includes the operation of directing a high pressure gas of the fluidizing gas flow at the ultrasonic nozzle. In claim 37, the high pressure gas of the fluidizing gas flow transports the atomized coating to the at least one medical appliance. It is respectfully submitted that neither the Schwarz reference nor the Park reference discloses, or even suggests, this feature. In particular, the Schwarz reference teaches away from using a high pressure jet to transport the atomized coating when it states that “[a]ny other nozzles may be only used to inject the coating material(s) into the chamber 120 at a low velocity so as not to disrupt the cyclical flow of air and medical devices.” (Schwarz; col. 9, ll. 8-11). As discussed above, the Park reference does not discuss an air suspension method at all. Therefore, the combination of the references does not render claim 37 unpatentable. It is therefore respectfully submitted that claim 37 is in condition for allowance.

Appl. No. 10/670,819
Reply to Office Action of June 21, 2004

CONCLUSION

Applicant respectfully submits that all of the pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Dated: Sept. 21, 2004

Respectfully submitted,

By: 

Brian E. Hennessey
Reg. No. 51,271
KENYON & KENYON
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646